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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 33

Application Number: 09/013,819

Filing Date: January 27/1998

Appellant(s): Ouderkirk et al.

William D. Miller

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/16/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 2 and 13 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of the claim under appeal.

5,157,526	Kondo et al	10-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 8, 9, 14 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al. This rejection is set forth in prior Office Action, Paper No. 25.

Claims 3-7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. This rejection is set forth in prior Office Action, Paper No. 25.

The rejection of claims 1, 5, 7 and 48 under 35 U.S.C. 103(a) as being unpatentable over Matsumoto in view of Schrenk et al is withdrawn.

(11) Response to Argument

I. The appellant argues that the reference to Kondo et al fails to teach a "reflective polarizer".

The examiner disagrees and states that appellant's broad recitation of the term "reflective polarizer" does not preclude element (7), as disclosed in Fig. 7 of the Kondo et al reference, as being considered as a reflective polarizer due to the fact that one polarization component, the parallel polarization wave component (P-wave), is reflected at a boundary between medium I and medium II while the other polarization component, the perpendicular polarization wave component (S-wave), is transmitted through the boundary.

The examiner is in agreement with the appellant that the S-wave is later converted to a P-wave and then transmitted through the polarizer. However, this additional conversion of the S-wave to a P-wave does not preclude the polarizer or that portion of the polarizer of Kondo et al as being a reflective polarizer. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Moreover, the appellant's use of the transitional phase "comprising" does not exclude the presence of additional, unrecited elements or function, such as in the present case of Kondo et al with "the additional conversion of the S-wave to a P-wave". See Moleculon Research Corp v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed, Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); and Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948).

II. The appellant argues that the reference to Kondo et al fails to teach the absorbing polarizer being "formed integral" with the polymeric reflective polarizer.

The examiner disagrees and states that Webster's New International Dictionary (Second Edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated.", as well as, Merriam-Webster's Collegiate Dictionary (Tenth Edition) defining "integral" as "(2) C: formed as a unit with another part.". Furthermore, in column 8, lines 65-67 of Kondo et al, Kondo et al clearly teaches that the dichromatic (absorbing) polarizer (13) is laminated with the reflective polarizer (7). Accordingly, the laminated parts of Kondo et al must be integral.

In regards to the appellant's argument that the reflective polarizer and the dichromatic (absorbing) polarizer are made as part of the same process, the examiner states even if one could possibly assert that the above language "formed integral" is drawn to a product-by-process

limitation. Product-by-process limitations in a claim drawn to structure is directed to the product per se no matter how actually made, see In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985), which makes clear that it is the patentability of the final product per se which must be determined in claims having product by process limitations and not the patentability of the process and that as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in product by process claims or not. In other words, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

III. The appellant argues that the reference to Kondo et al fails to teach providing antireflection one side of a reflective polarizer to produce an optical polarizer that reflects light from one side and not the other.

In response to appellant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. providing antireflection one side of a reflective polarizer "to produce an optical polarizer that reflects light from one side and not the other") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner is of the opinion that it is clear from Fig. 7 of Kondo et al that the dichromatic (absorbing) polarizer (13) is positioned on at least one side of the reflective polarizer (7). While, Kondo et al is silent with respect to stating that the dichromatic (absorbing) polarizer provides "antireflection", due to the fact that light travels through the interface between the

reflective polarizer and dichromatic (absorbing) polarizer without reflection, the dichromatic (absorbing) polarizer of Kondo et al obviously provides antireflection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RDS
December 1, 2002

Conferees:
C. Spyrou
A. Grimley
R. Shafer